

REMARKS

Review and reconsideration of the Office Action dated July 25, 2005, is respectfully requested in view of the above amendments and the following remarks.

First, Applicants would like to point out to the Examiner that Claim 6 was cancelled during the Preliminary Amendment.

Applicants are pleased to see that the Examiner indicated that Claims 2-4, 6, 9, and 11 contain allowable subject matter. Applicants believe that the remaining claims are also novel and not obvious over the cited art.

In order to overcome the formalities rejection to the specification, Applicants are submitting herewith a substituted specification. Entry of the substitute specification is respectfully requested.

Claims 1 and 5 have been amended. Support for the claim amendment can be found on Paragraph [00060] of the specification as originally filed. Paragraph [00060] refers to the preparation of the alicyclic esters of formula I in accordance with synthesis route B.

Claim 2 has been amended to correct a translation error. The term "hydrogen" has been replaced with the term "oxygen".

No new matter has been added to the claims or the specification.

Applicants believe that Claims 1 and 5 are novel and not obvious over the cited prior art because the Schleppnik reference fails to teach formula I when $Y = -CR^7R^8OCOR^9$, where R^7

and R^8 - independently of one another - are H or CH_3 and R^9 is a branched or straight-chain C_1 to C_5 alkyl group or a branched or straight-chain C_2 to C_5 alkylene group.

Applicants reviewed the reference and note that the reference only teaches formula I when $Y = R^9$. The claims as presently amended required $Y = -CR^7R^8OCOR^9$.

Office Action

Turning to the Office Action, the paragraphing of the Examiner is adopted.

Specification (Formalities)

The Examiner indicated that the lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which application may become aware of in the specifications.

In order to overcome any possible formality rejection to the specification, Applicants are submitting herewith a substituted specification. Entry of the substitute specification is respectfully requested.

Claims Rejections - (Formalities)

The Examiner rejects Claims 7 and 8 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The position of the Examiner can be found on page 3 of the Office Action.

In response, Applicants had amended Claims 7 and 8 by adding the "carrier" limitation.

Accordingly, withdrawal of the rejection is respectfully requested.

Claims Rejection - (Anticipation)

The Examiner rejects Claims 1, 5, 7, 8, 10, and 12 under 35 U.S.C. 102(b) as being anticipated by Schleppnik (US 4,622,221 11-1986).

The position of the Examiner can be found on pages 2-3 of the Office Action.

Applicants respectfully traverse.

Regarding Claims 10 and 12

Applicants note that Claims 10 and 12 depends on Claims 2-3, respectively. Please note that the Examiner already indicated that Claims 2-3 contain allowable subject matter. Thus, these Claims also contain allowable subject matter in view of their dependency with Claims 2-3.

Regarding Claims 1 and 5

Applicants reviewed the Schleppnik reference and note that compared with Claims 1 and 5, the reference fails to teach formula I when $Y = -CR^7R^8OCOR^9$, where R^7 and R^8 - independently of one another - are H or CH_3 and R^9 is a branched or straight-chain C_1 to C_5 alkyl group or a branched or straight-chain C_2 to C_5 alkylene group.

Applicants reviewed the reference and note that the reference only teaches formula I when $Y = R^9$. The claims as presently amended require Y to be equal to $Y = -CR^7R^8OCOR^9$.

Regarding the **second part of the alternative b)** of Claim 1, (Y R⁹ Schleppnik, Applicants note that the cyclohexyl ring of the cited reference is not substituted with a methyl group.

Thus, Claims 1 and 5 and novel and not obvious over the cited art, because the claims as presently amended fail to teach a compound of formula I when Y = -CR⁷R⁸OCOR⁹.

Regarding Claims 7 and 8

These claims are novel in view of their dependency with novel Claim 1.

Accordingly, withdrawal of the rejection is respectfully requested.

Claims Objections

The Examiner objects Claims 2-4, 6, 9, and 11 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim.

The position of the Examiner can be found on page 3 of the Office Action.

Applicants traverse for the same reasons as set forth in the previous paragraph and the following remarks.

Claim 2 has been amended to correct a translation error. The term "hydrogen" has been replaced with the term "oxygen".

No new matter has been added to the claims or the specification.

In addition, Claims 2-4, 9, and 11, are novel in view of their dependency with novel Claim 1.

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AMENDMENT A

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Accordingly, withdrawal of the objection is respectfully requested.

Allowable Subject Mater

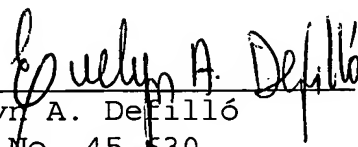
The Examiner indicated that Claims 2-4, 6, 9, and 11 are drawn to allowable subject matter. The following is a statement of reasons for the indication of allowable subject matter: The instantly claimed compounds, compositions, and processes are neither disclosed nor fairly suggested by the closest prior art: Schleppnik (US 4,622,221 11-1986), Giersch, et al. (US 5,166,412 11-1992), and Williams (US RE 38,659 11-2004).

The position of the Examiner can be found on pages 3-4 of the Office Action.

Applicants are pleased with the indication. Furthermore, Applicants believe that the remaining claims are also allowable.

Favorable consideration and early issuance of the Notice of Allowance are respectfully requested. Should further issues remain prior to allowance, the Examiner is respectfully

Respectfully submitted,


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